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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,613	03/23/2004	Hong Liu	P1095US10	4470

29490 7590 10/30/2007
GENOMICS INSTITUTE OF THE
NOVARTIS RESEARCH FOUNDATION
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EXAMINER

ANDERSON, REBECCA L

ART UNIT	PAPER NUMBER
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1626

NOTIFICATION DATE	DELIVERY MODE
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10/30/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPLegal@gnf.org
jclarke@gnf.org

Office Action Summary	Application No. 10/807,613	Applicant(s) LIU ET AL.	
	Examiner Rebecca L. Anderson	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,7-9,16-19,27,28 and 38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4 and 27 is/are rejected.
- 7) ☒ Claim(s) 7-9,16-19,28 and 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1, 4, 7-9, 16-19, 27, 28 and 38 are currently pending in the instant application. Claims 1, 4 and 27 are rejected. Claims 7-9, 16-19, 28 and 38 are objected.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 October 2007 has been entered.

Response to Amendment and Arguments

Applicants' amendment and arguments filed 12 October 2007 have overcome the pending claim objection as containing non-elected subject matter. The pending claims have been searched and examined in their entirety. However, applicants' amendment has necessitated the following new claim objection and rejection. Applicants' claims 1, 4 and 27 are now rejected under 35 USC 112 1st paragraph for containing new matter. While applicant stated that no new matter has been added as the compound of formula I(i) and I(j) correspond to the formula in claim 9 and claim 18 except for R3, R6, R7 and R8 and the variables R3, R6, R7 and R8 are as defined for original formula I, it is noted that the instantly claimed formulas I(i) and I(j) appear nowhere in applicant' originally filed disclosure and are a subgenus that does not find support in the originally

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filed disclosure. The genus of formula (I) does not provide support for the new subgenus, nor do the examples present in the specification, wherein R3, R6, R7 and R8 are almost always hydrogen, provide support for the new subgenus.

Claim Objections

Claims 7-9, 16-19, 28 and 38 are objected to as being dependent upon a rejected base claim, but would appear allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 4 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, claim 1 has been amended to include the new formulas of I(i) and I(j) which are considered new matter as they are found nowhere in applicants' originally filed disclosure. Applicant has not provided support for formulas I(i) and I(j) by providing page and line numbers. The specifications broad recitation of formula I, the formulas in claims 9 and 18 and examples of specific compounds wherein R3, R6, R7 and R8 are almost always hydrogen do not provide support for new formulas I(i) and I(j) as the examples only provide

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support for themselves and not for a subgenus which is not disclosed or described in the original filed disclosure. The broad recitation of Formula I also does not provide support for a narrowing to a subgenus, nor does the recitation of varying subgenus formulas provide support for a different subgenus. According to *In re Ruschig* 379 F.2d 990, 154 USPQ 118 (CCPA 1967) and *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1326, 56 USPQ2d 1481, 1486 (Fed. Cir. 2000)., "Rushig makes clear that one cannot disclose a forest in the original application, and then later pick a tree out of the forest and say "here is my invention." In order to satisfy the written description requirement, the blaze marks directing the skilled artisan to that tree must be in the originally filed disclosure." While *In re Johnson*, 558 F.2d 1008, 195 USPQ 187, 196 (CCPA1977) shows us that if alternative elements are positively recited in the specification, they may be explicitly excluded in the claims, applicant has not excluded alternative elements that are positively recited in the specification but has limited the genus disclosed in the specification to a specific sub-genus which has no basis in the original disclosure, i.e. there are no examples found, nor a sub-genus found in the specification which includes the subgenus of formulas I(i) and I(j)

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday from 6:00am until 2:30pm.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Rebecca Anderson/
Primary Examiner, AU 1626*

25 October 2007

Rebecca Anderson
Primary Examiner
Art Unit 1626, Group 1620
Technology Center 1600